

### Remarks

Claims 1-21, 38, and 40-44 are pending in the application with none of the claims having been allowed. Claims 1-4, 6-7, 9-12, 14-15, 18-19, 21, 36-41 and 44 stand rejected under 35 U.S.C. 102(e) as being anticipated by Petrick (US 6,535,129B1). Claims 5, 8, and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petrick. Claims 16, 17, 20, 38, 42, and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Petrick in view of Hoffman et al. (US 5,613,012).

Petrick is not prior art to this application because the subject matter of the claims of the present application was invented prior to the filing date of the Petrick application. Applicants' invention was conceived before November 17, 2000, the filing date of the Petrick reference, as set forth in the attached declarations with supporting documents under Rule 1.131. Applicant's filing date of December 14, 2000 constitutes the reduction to practice of the invention, and the Rule 1.131 Declarations establish diligence in the intervening period of 27 days. See *Sletzing v. Lincoln*, 410 F.2d 808, 161 USPQ 725 (CCPA 1969); *Rines v. Morgan*, 250 F.2d 365, 116 USPQ 145 (CCPA 1957). Submission of these declarations remove Petrick as a reference, but should not be construed as admitting that the Petrick reference discloses or makes obvious applicant's claimed invention.

Claims 1, 6-7, 9-10, 14-15, 18-19, 21, 40-41, and 44 stand rejected under 35 U.S.C. 102(b) as being anticipated by Berney (US 5,777,303). In the examiner's view, a population of collection vessels with members located at various locations in the specimen path is an intrinsic feature of the Berney invention, and the methods of electronically storing and recording information, recited in claims 18, 19, and 21 are inherently disclosed in the Berney specification.

The Berney reference discloses a system that permits securing an electronic label on a test tube with the aid of a detachable support. The support allows an easy connection between the label and a device for reading/writing the label, allowing a registration of the entirety of useful information of, for example, a blood analysis and a transfer of the content of the label to a computer-assisted database for data treatment and storage.

The claims of the present application rejected as anticipated by Berney are directed to a diagnostic specimen system comprising a population of biomedical specimen collection

vessels, each having a wireless electronic memory tag attached to the vessel for non-contact storage and retrieval of information, wherein the population includes a members located at a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory. Having members of such a population dispersed in this fashion is not inherent or intrinsic to Berney.

An anticipatory inherent feature must be consistent, necessary, and inevitable, not merely possible, or probable, 1 DONALD S. CHISUM, CHISUM ON PATENTS § 3.03[2][b] (2003)((citing, inter alia, *Transclean Corp. v. Bridgewood Services, Inc.* 290 F.3d 1364, 1373, 62 USPQ2d 1865 (Fed Cir. 2002), *Eli Lilly & Co. v. Barr Laboratories, Inc.*, 251 F.3d 955, 970 58 USPQ2d 1865 (Fed Cir. 2001, *cert denied*, 122 S.Ct. 913 (2002))), and the presence of members of a population of vessels at a vessel distribution facility, a specimen collection facility, and a specimen testing laboratory is not an inevitable result of implementation of the Berney disclosure. Since Berney addresses a testing laboratory, the members would be present there, but not the other two locations. The labels are mounted on supports provided to fix the labels onto the test tubes during the time of analysis (see column 1, lines 33-37 of Berney). The affixation does not occur until the test tubes are at the laboratory at the time of analysis. Their presence on the test tubes is not inevitable at the vessel distribution facility or at the specimen collection facility.

The Berney reference explicitly discloses neither members of a population of vessels at a vessel distribution facility nor a specimen collection facility. In fact, the system disclosed in Berney is intended for use only within a diagnostic laboratory. This is evidenced by Berney's specific disclosure of a detachable support 3 on which an electronic label 4 can be fixed, as shown in Figure 1 of the reference. The detachable nature of the support 3 renders the system disclosed in Berney unsatisfactory for use for a population of vessels having members located at a distribution facility, collection facility, and testing laboratory. The support disclosed in Berney is susceptible to becoming detached from the vessel during transit from, for example, the collection facility to the testing laboratory. The claims of the present application are therefore not anticipated by Berney because a population of collection vessels as claimed is neither a consistent, necessary, nor inevitable feature of the Berney reference.

Therefore, the diagnostic specimen system as claimed in claims 1, 6-7, 9-10, 14-15, 18-19, 21, 40-41, and 44 of the present application is not inherent in the Berney reference.

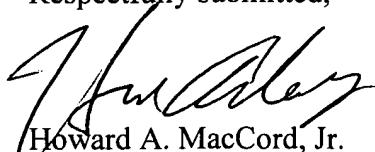
The examiner objected to claims 1, 5, 9, 17-21, 38 and 40-44 because of various informalities in the claim language. These objections have been answered by the foregoing amendments to the claims.

The examiner rejected claim 44 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. In the examiner's view, it is not clear from the way the claim is written if the containers of claim 44 have anything in common, or whether they are three different containers; in the latter case, it is not clear what is the essence of the step of providing three containers at different locations.

In response to the examiner's objection of claim 44, it is pointed out that the three containers have in common that each are part of the same population of specimen vessels, as specifically recited in the claim language. Thus, they have something in common. With regard to the question whether they are three different containers; the members are part of a population of specimen vessels, at least one at a vessel distribution facility, one at a specimen collection facility, and one at a specimen testing laboratory. Thus, from the claim language, they must be three different containers since the three facilities are distinct and separate.

Thus, the applicant submits that by this amendment he has placed the case in condition for immediate allowance and such action is respectfully requested. However, if any issue remains unresolved, Applicant's attorney would welcome the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



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